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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/696,661   | 10/28/2003  | Brent Neudorf        | 571                 | 6848             |
| 47851  | 7590        | 09/01/2005           | EXAMINER            |                  |
| KEITH KLINE<br>THE KLINE LAW FIRM<br>161 LITTLE POND LANE<br>PALMYRA, VA 22963 |             |                      | WOLFE, DEBRA M      |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 3725                |                  |

DATE MAILED: 09/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/696,661

Applicant(s)

NEUDORF, BRENT

Examiner

Debra Wolfe

Art Unit

3725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on October 28, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4 and 6-16 is/are allowed.
- 6) ☒ Claim(s) 17 is/are rejected.
- 7) ☒ Claim(s) 18 and 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_



## DETAILED ACTION

### *Information Disclosure Statement*

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the mounting legs that are adjustable in length, as claimed in claim 5, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an



application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: notcher positioning mechanism 30. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 24. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New



Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Specification*

1. The disclosure is objected to because of the following informalities:

1. Page 7, line 8 reference numeral 1611 refers to the support projections but on page 7, line 16 the same reference numeral (1611) refers to the side projections

Appropriate correction is required.

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: a table comprising of mounting legs that are adjustable in length such that the table can be mounted stably on angled surfaces, there is no mention of the mounting legs for the table in the specification or the structure that allows the mounting legs to be adjustable.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described



in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 5 states that the table is to have mounting legs that are adjustable in length such that the table can be mounted stably on angled surfaces, the disclosure does not provide a basis for this claimed subject matter or a description of the structure required to allow the mounting legs to be adjustable in length such that one skilled in the art would be able to replicate the adjustable mounting legs without undue experimentation.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
1. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chubb et al (U.S. Patent # 6,085,569). Chubb et al discloses a heavy duty sheet bending brake having a hold down (fixed member, 13) with a clamping surface (14), a panel support (anvil member, 17) and a brake



plate (bending member, 16) with a brake handle (handle, H). Chubb et al discloses the claimed invention except for wherein a tool adapted to hem an exposed tongue has an angled panel support such that a roofing panel is secured on the panel support by the hold down and pressure is applied to the tongue by the brake handle so that the tongue is bent around a brake pivot on an end of the panel support. It would have been obvious to one having ordinary skill in the art at the time the invention was made to rotate the support panel and the hold down by 180 degrees to bend the tongue downward instead of upward as disclosed by Chubb et al, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. (See FIG 1-3)

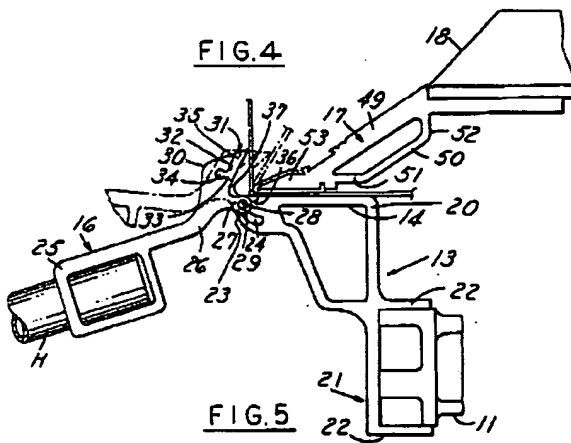


FIG 1: Chubb et al (original)

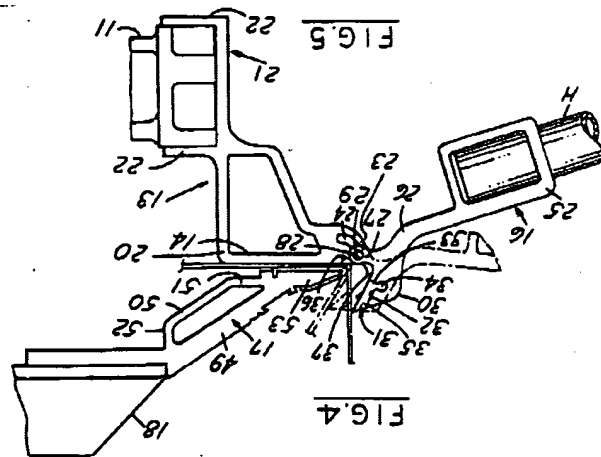


FIG 2: Chubb et al (rotated 180 degrees)

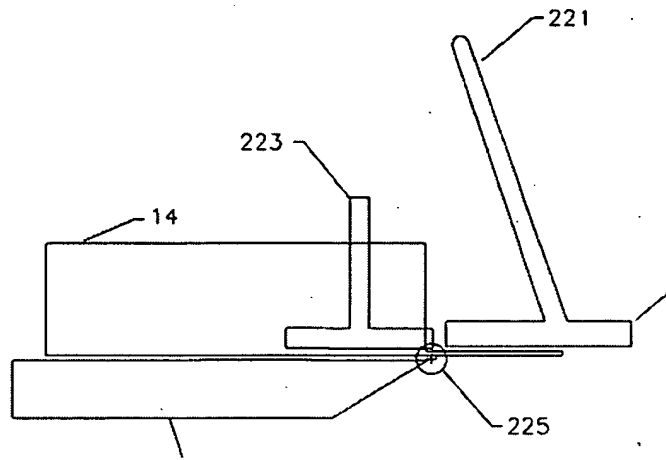


FIG 3: Applicant's claimed Hemmer

*Allowable Subject Matter*

1. It is the opinion of the examiner that the art of record (considered as a whole) neither anticipates nor renders obvious "a tool adapted to finish end pieces of roofing panels comprising ...at least one of said notching device is movable relative to the other said notching device, so that a notch formed by said first notching device can be made at a different longitudinal position along a first side wall of the roofing panel relative to a notch formed by said second notching device, thereby enabling variation of an angle between said notch formed by said first notching device and said notch formed by said second notching device" in combination with the rest of the claimed limitations set forth in the independent claim.

Further searching by the examiner yielded additional prior art as follows:

2. Berry (U.S. Patent # 3,982,457) discloses a notching machine having a straight line assembly including a notching means (14), a shearing means (16), and a roll former RB means (18). The notching means disclosed by Berry comprises of three notchers, a movable end notcher (78), a fixed end notcher (80) and a movable diamond notcher (82). (See FIG 2) Estes (U.S.



Patent Publication # 2002/0121124 A1) discloses a dual notcher having two notching units opposing one another housed within a single member.

3. However the above cited prior art fails to disclose a first and second notching device that are independent of one another in such a way that "a notch formed by said first notching device can be made at a different longitudinal position along a first side wall of the roofing panel relative to a notch formed by said second notching device, thereby enabling variation of an angle between said notch formed by said first notching device and said notch formed by said second notching device." Therefore, it is concluded by the examiner that claim 1 – 4 and 6 - 12 of the present invention is allowable subject matter.

4. It is the opinion of the examiner that the art of record (considered as a whole) neither anticipates nor renders obvious "a tool adapted to notch a side wall of a roofing panel comprising ...wherein said bottom die comprises at least one supporting projection, said supporting projection being adapted to enter an open area of a female side wall of the roofing panel, and said top die comprises a slot to receive said supporting projection of said bottom die, so that a clean cut of the side wall of the roofing panel is achieved" in combination with the rest of the claimed limitations set forth in the independent claim.

Further searching by the examiner yielded additional prior art as follows:

5. Stubberfield et al (U.S. Patent # 4,446,623) discloses a notching tool having a die plate (33), a notching aperture (34), a notching head (24), a punch (40) and a handle (45). Estes (U.S. Patent Publication # 2002/0121124 A1) discloses a dual notcher having a first die (118) and punch (116) and a second die (114) and punch (112) whereby the first die cooperates with the



second punch to form a notch and the first punch cooperates with the second die to form a second notch.

6. However the above cited prior art fails to disclose a notching tool wherein the "top die comprises a slot to receive said supporting projection of said bottom die, so that a clean cut of the side wall of the roofing panel is achieved." Therefore, it is concluded by the examiner that claim 13 - 16 of the present invention is allowable subject matter.

7. Claim 5 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

8. Claims 18-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. U. S. Patent Publication # 2003/0188561 A1 to Clark
2. J.P. Patent # 402175024A to Nakayama et al

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra Wolfe whose telephone number is (571) 272-1904. The examiner can normally be reached Monday - Thursday 6am - 3:30pm with alternating Fridays 6am - 2:30pm.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached at (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Debra Wolfe  
Examiner  
Art Unit 3725

A handwritten signature in black ink, appearing to read "Derris H. Banks", is written over a horizontal line.

**DERRIS H. BANKS**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3700**